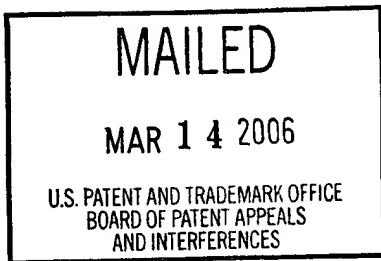


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte ASIT DAN, DANIEL M. DIAS and JOSEPH L. HELLERSTEIN



Appeal No. 2005-2312
Application No. 09/642,526

ON BRIEF

Before BARRETT, CRAWFORD, and LEVY, Administrative Patent Judges.
CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 26, which are all of the claims pending in this application.

The appellants' invention relates to an internet service site supporting one or more organizations providing service level agreements ("SLA") for each of these organizations (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Main et al. (Main)	5,893,905	Apr. 13, 1999
O'Brien, et al. (O'Brien)	WO 97/29443	Aug. 14, 1997

The rejections

Claims 1 to 6, 10 to 18, and 22 to 26 stand rejected under 35 U.S.C. § 102(b) as being anticipated by O'Brien.

Claims 7 to 9 and 19 to 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over O'Brien in view of Main.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (mailed August 19, 2004) and the final rejection (mailed August 19, 2003) for the examiner's complete reasoning in support of the rejections, and to the brief (filed January 26, 2004) and reply brief (filed October 21, 2004) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the

respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

We turn first to the examiner's rejection of claims 1 to 6, 10 to 18 and 22 to 26 as being unpatentable over O'Brien. We initially note that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

The examiner finds that O'Brien discloses:

. . . an apparatus for use in a computer hosting services environment, the apparatus comprising: at least one processor (O'Brien; page 1, lines 6 to 13) operative to: (1) construct an electronic service level agreement between a service provider and a client based on client input for an application associated with the client to be hosted by the services provider (O'Brien; page 8, lines 18 to 29 and page 16, lines 11 -21); and (ii) check the consistency of the electronic service level agreement with respect to one or more existing electronic service level agreements previously committed to by the service provider (O'Brien; page 3, lines 18-22 page 6, lines 23-28 and 32-page 7, line 6). [answer at page 3]

Appellants argue that O'Brien does not describe an apparatus having a processor which checks the consistency of the SLA with respect to one or more existing SLAs previously committed to by the service provider. In appellants' view, O'Brien's checks are based on estimates of parameters in regard to capacity and not on actual existing SLAs.

O'Brien describes that the processor therein disclosed makes a decision to provide a service based on stored parameters rather than on real time information. These parameters include the amount of work already being done by the system (page 6, line 25) on existing SLAs. As such, the decision to provide service is based on existing SLAs.

Therefore, we agree with the examiner that O'Brien does indeed described a processor that checks the consistency of an SLA with respect to one or more existing SLAs previously committed to by the service providers, as broadly recited in claim 1. While appellants are correct that O'Brien makes the decision based on estimates of the available CPU capacity, based on, for example, past resource performance of the system rather than the actual present CPU capacity, such estimate is nonetheless based on data with respect to existing SLA previously committed to by the service provider.

Appellants also argue that O'Brien fails to disclose a computer hosting services environment but rather discloses a service provisioning system. We note that claim 1 recites an apparatus "for use in a computer hosting services environment" and client input "for an application associated with the client to be hosted by the service provider."

We view the above referenced language of the claim to relate to the intended use of the system. Therefore, we do not find this argument persuasive because the manner or method in which a machine is to be utilized is not germane to the issue of patentability of the machine itself. In re Casey, 370 F.2d 576, 580, 152 USPQ 235, 238 (CCPA 1967). A statement of intended use does not qualify or distinguish the structural apparatus claimed over the reference. In re Sinex, 309 F.2d 488, 492, 135 USPQ 302, 305 (CCPA 1962). There is an extensive body of precedent on the question of whether a statement in a claim of purpose or intended use constitutes a limitation for purposes of patentability. See generally Kropa v. Robie, 187 F.2d 150, 155-59, 88 USPQ 478, 483-87 (CCPA 1951) and the authority cited therein, and cases compiled in 2 Chisum, Patents § 8.06[1][d] (1991). Such statements often, although not necessarily, appear in the claim's preamble. In re Stencel, 828 F.2d 751, 754, 4 USPQ2d 1071, 1073 (Fed. Cir. 1987).

Therefore, the fact that the claims call for the apparatus to be used in a computer hosting environment does not patentably distinguish the claims from the apparatus described in O'Brien.

In any case, as O'Brien discloses that a personal computer connects to a network for the provision of a service, O'Brien does describe an apparatus for use in a computer hosting service environment. (See page 1, lines 12-18, page 3, lines 23-25, page 4, lines 14-19, page 8, lines 18-29)

Appellants also argue that O'Brien describes a system in which an agent negotiates with other agents in order to access any needed component processes in fulfilling the requested service so that the SLAs are between agents not between a client and an agent.

We do not agree. While O'Brien does describe a system in which SLAs exist between agents, O'Brien also describes a system wherein SLAs exist between agents and clients for the direct provision of services (page 3, lines 18 to 22).

In view of the foregoing, we will sustain the examiner's rejection of claim 1 under 35 U.S.C. § 102 as being anticipated by O'Brien. We also sustain this rejection as it is directed to claims 2 to 6, 10 to 18 and 22 to 25 as these claims stand or fall with claim 1 (brief at page 3).

In regard to claim 26, appellants, without detailed discussion, allege that O'Brien fails to disclose a SLA building module, a provisioning module and an execution system which executes the constructed SLA.

We agree with the examiner that O'Brien describes a SLA building module in the form of a negotiation management module 51 which constructs the SLA s and commits

to the contract based on stored parameters which relate to existing SLAs and modifies SLAs when an inconsistency is found (page 16, lines 11 to page 17 line10). We also agree with the examiner that O'Brien also describes a provisioning module 52 which provisions one or more resources of an infrastructure in accordance with the constructed SLAs (page 17, lines 11 to 18) and an execution system which executes the constructed SLAs 53 (page 17, lines 19 to 28).

Therefore, we will sustain the examiner's rejection of claim 26 as well.

We turn next to the examiner's rejection of claims 7 to 9 and 19 to 21 under 35 U.S.C. § 103 as being unpatentable over O'Brien in view of Main. The examiner recognizes that O'Brien does not describe providing a warning or alarm that a portion of the SLA is violated or near-violated. The examiner relies on Main for teaching a processor that is operative to provide a warning or alarm that a portion of an SLA is violated or near violated and directs attention to the abstract of Main. The examiner concludes:

it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the system taught by O'Brien with Main's teaching with regards to this limitation, with the motivation of alerting service requestor of the potential impact of SLA violation (Main, abstract). [answer at page 6].

Appellants argue that there is no motivation to combine the teachings of O'Brien and Main and that the examiner has not explained how the references can be combined to achieve the present invention.

O'Brien teaches a system for provisioning SLAs and that these SLAs include a requested time in which the service is to be provided (see page 6, lines 20 to 22). Main teaches that a system that notifies a user of any problems with a SLA, i.e. the job is in danger of not being met by the specified time (Abstract). In our view, there is ample motivation to provide the system of O'Brien with a the notification system described in Main to achieve the advantage taught by Main:

...If a job abnormally terminates and must be restarted, the impact to downstream jobs must be quickly analyzed so that appropriate actions, such as starting a job earlier than scheduled, may be taken. What is needed is an automated process to monitor job execution while comparing each job against its SLA in order to manage downstream jobs [col. 1, lines 55 to 60]

In regard to the appellants' argument that the examiner has not explained how the references can be combined, we agree with the examiner that it is not necessary for the references themselves to be bodily incorporated. In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981); In re Sneed, 710 F.2d 1544, 1550, 218 USPQ 385, 389 (Fed. Cir. 1983).

Therefore, we will sustain the examiner's rejection of claims 7 to 9 and 19 to 21 under 35 U.S.C. § 103 as being unpatentable over O'Brien in view of Main.

The examiner's rejection of the appealed claims is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED


LEE E. BARRETT
Administrative Patent Judge


MURRIEL, E. CRAWFORD
Administrative Patent Judge


STUART S. LEVY
Administrative Patent Judge

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